

REMARKS

Claims 1-10, 12, 13, 15-18, 20-27, and 33-36 are presently pending. Claim 11 has been canceled. Claims 14, 19 and 28-32 were previously canceled. Claims 1, 5, 6, 9, 12, 20 and 24 have been amended.

Applicants respectfully request reconsideration of the application in view of the foregoing amendments and the remarks appearing below, which Applicants believe place the application in condition for allowance. It is Applicants' position that even though the claims have been amended after a final rejection, they should be allowed in view of the arguments presented below. This is particularly so because many of the amendments made to the independent claims are directed to subject matter that was already considered by the Examiner due to its presence in dependent claims prior to the present Office Action. Consequently, Applicants believe there are no significant new issues raised by the amendments that would require an additional search.

Rejections under 35 U.S.C. § 102

Young

The Examiner has rejected claims 1, 33, 34 and 36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,689,418 to Young, stating that Young discloses a device having all of the limitations of these claims.

Young discloses a method of decorating a flower pot (appears to be an ordinary clay pot) by covering the exterior of the sidewall with plaster of paris and embedding decorative cinders into the plaster of paris.

Prior to addressing the merits of the rejection, Applicants wish to correct an apparent misapprehension by the Examiner of the immediately preceding paragraph, which also appears in Applicants' prior Response filed October 27, 2005 ("the 10/27/05 Response"). In the first paragraph below the bold-type paragraph on page 10 of the present Office Action the Examiner appears to be refuting the Applicants statement (underlined above) that the flower pot that Young teaches can be decorated "appears to be an ordinary clay pot." In making this refutation, the

Examiner states that a “clay pot is not made out of plaster of Paris, aluminum bronze and vinegar.” While this statement is facially true, it misapprehends Applicants’ statement.

Applicants’ assertion is that the flower pot that is being decorated in the Young patent, i.e., the “ordinary flower pot” labeled as element 10 in Young’s FIG. 2, is most likely an ordinary clay pot. Young patent, col. 1, lines 25-26. Indeed, Young states:

[T]he numeral 10 indicates an ordinary flower pot, to the outer surface of which, in accordance with my invention, I apply a coating 11 consisting of a mixture of plaster of Paris, aluminum bronze and vinegar.

Young patent, col. 1, lines 25-29 [emphasis added]. This excerpt from the Young patent uncontrovertibly supports Applicants’ assertion that Young’s ordinary flower pot, i.e., the base pot to which the coating is applied, is most likely an ordinary clay flower pot that was commonly available in the 1920s when Young made his invention. Nowhere in their 10/27/05 Response did the Applicants assert that Young’s pot, once decorated in accordance with the patent, was just an ordinary clay pot. In essence, what is implied by Applicants’ prior argument is that Young’s decorated pot is an ordinary clay pot ornamented in the manner described by Young in the patent. Consequently, the Examiner’s implication that Applicants’ remark about the clay pot are false is incorrect.

Turning to the present rejection on the merits, Applicants have amended claim 1 to include, among other things, the limitations that the walls of the container comprise a plurality of elongate fibers that define a plurality of passageways that allow roots to grow therethrough. (These limitation were previously considered by the Examiner, e.g., relative to previously presented claim 5 and 12.) Clearly, Young does not disclose or even remotely suggest these limitations. Young’s pot is made of a clay pot having solid walls, i.e., not having passageways, and a solid coating/particle layer applied to the clay pot. This additional layer also has no passageways. Clearly, none of the components disclosed by Young could reasonably considered to be made of elongate fibers. Therefore, the Young patent cannot anticipate amended claim 1, nor claims 33, 34 and 36 that depend from claim 1.

In connection with rebutting Applicants’ prior argument supporting the patentability of claim 33, on page 12 of the present Office Action the Examiner asserts that “when one set [sic] the bottom wall on the ground or support surface, the bottom wall is not exterior . . .” This is

nonsensical. The exterior (Definition: "the outer side or surface of something," www.onelook.com) of an object does not cease to be the outer side, i.e., exterior, of that object just because it is rested on a support. Indeed, when an object is rested on a support, the exterior of the object confronts the support. In the Young patent, when the pot is rested on a supporting surface the exterior of the bottom wall confronts the supporting surface, it does not cease to exist.

Shiraishi

The Examiner has rejected claims 1, 4, 33, 34 and 36 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,689,418 to Young, stating that Young discloses a device having all of the limitations of these claims.

Shiraishi discloses an ornamented bottle made by cementing lava rocks to an ordinary bottle, such as a glass bottle.

As mentioned above relative to the rejection in view of the Young patent, Applicants have amended claim 1 to include, among other things, the limitations that the walls of the container comprise a plurality of elongate fibers that define a plurality of passageways that allow roots to grow therethrough. (Again, these limitation were previously considered by the Examiner, e.g., relative to previously presented claim 5 and 12.) Clearly, Shiraishi does not disclose or even remotely suggest these limitations. Shiraishi's decorated bottle is made of a bottle having solid walls, i.e., not having passageways, and a solid cement/lava rock layer applied to the bottle. This additional layer also has no passageways. Clearly, none of the components disclosed by Shiraishi could reasonably considered to be made of elongage fibers. Therefore, the Shiraishi patent cannot anticipate amended claim 1, nor claims 4, 33, 34 and 36 that depend from claim 1.

For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the anticipation rejections in view of the Young and Shiraishi patents.

Rejections under 35 U.S.C. § 103

Fernando et al. and Young

The Examiner has rejected claims 1, 5-8, 11, 12, 15-17 and 24 under 35 U.S.C. § 103 as being obvious in view of Germany patent document DE 019907577 C1 to Fernando et al. and the Young patent, discussed above, stating that Fernando et al. disclose all of the limitations of these

claims except for the rodent deterrent. The Examiner then states that Young discloses a rodent deterrent and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Fernando device with the rodent deterrent taught by Young. Applicants respectfully disagree.

The Young patent is described above in connection with the anticipation rejection.

Fernando et al. disclose a biodegradable pot for growing or germinating plants. The pot is made of coir fibers secured together with latex. The Fernando et al. pot includes a lower section that contains a mesh of fibers that define apertures that ensure that the fiber material does not degrade prematurely while the plant roots grow and to drain a buildup of water inside the pot.

Each of independent claims 1, 12 and 24 includes a limitation directed to the rodent deterrent being attached to the container so as to not block passageways or openings defined by the fibers that make up the container. Clearly, this would not be the case with the Fernando et al./Young combination asserted by the Examiner. Young's decoration is made by applying a continuous layer of plaster of Paris to a pot and then embedding cinders partially into the plaster of Paris. If the Young decoration were applied to the Fernando et al. pot, the plaster of Paris would block every passageway or opening in the Fernando et al. pot. Consequently, the resulting decorated Fernando et al. pot would not have the claim limitation of the rodent deterrent not blocking the passageways/openings. Therefore, the Fernando et al./Young combination cannot render obvious claims 1, 12, 20 and 24, nor claims 5-8 and 15-17 that depend therefrom. (Claim 11 has been canceled.)

In addition, Applicant maintain the position that the Fernando et al./Young combination is improper because the combination "changes the principle of operation" of the Fernando et al. pot. MPEP § 2143.01(VI). In particular, principles of operation of the Fernando et al. pot include the draining of water through openings in the mesh of coir fibers, the complete biodegradable nature of the pot and durability of the pot when exposed to water.

First, applying the Young decoration over the entire sidewall of the Fernando et al. pot as Young teaches would cover all of the openings in the mesh. This is so because Young teaches a continuous plaster of Paris layer over the entire sidewall surface for holding the cinders. In this connection, the Examiner asserts on page 13 of the present Office Action that there are gaps

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between the cinders of Young's decoration through which roots may grow. This is incorrect. Young clearly teaches that the entire exterior surface of the sidewall is coated with plaster of Paris into which the cinders are pressed. The plaster of Paris is continuous (see, e.g., Young's FIG. 2) and does not provide any gaps for root growth.

Second, as mentioned, another principle of operation of the Fernando et al. pot is its completed biodegradable nature. While plaster of Paris will dissolve with continued exposure to water (see the attached Webpage copy), the cinders are not biodegradable. Indeed, they are made of inorganic material that does not biodegrade. This non-biodegradability destroys the complete biodegradability espoused by Fernando et al. as being important to their pot.

Third, as just mentioned, and as those skilled in the art know, plaster of Paris is water-soluble and, as such, would not last long on the Fernando et al. pot, which is designed to weep water and get wet when the plants therein are watered. Someone skilled in the art would simply not be motivated to make this combination, which would result in the Fernando et al. not being able to be used in its intended manner for fear of the decorative layer disintegrating or being of such an inferior quality due to the rapidly disintegrating nature of the decorative layer.

Fourth, by the very nature of its construction the Fernando et al. pot is very flexible in a radial direction. Indeed, the pot is made of a thin layer of coir fibers held together with latex rubber. On the other hand, Young's decoration has only a thin layer of plaster of Paris. In the case of Young's pot, this is obviously not a problem because the plaster of Paris is applied to a rigid clay pot. However, Young's decoration would fail on the Fernando et al. pot when handled because the thin plaster of Paris layer would be too weak. Someone skilled in the art simply would not make the combination because the resulting decorated pot would be so fragile, not to mention that the intended functionality would be destroyed.

For at least these reasons, such a combination contravenes the law on *prima facie* obviousness. There certainly is no suggestion in the references themselves to make this combination. Indeed, Applicants assert that the only motivation to make the combination comes from the present claims themselves. Thus, the combination is improper.

In view of the foregoing, Applicants respectfully request that the Examiner withdraw the present rejection.

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Young and Kawaguchi et al.

The Examiner has rejected claims 2 and 3 under 35 U.S.C. § 103 as being obvious in view of the Young patent, discussed above, and further in view of U.S. Patent No. 5,675,933 to Kawaguchi et al., stating that Young discloses all of the limitations of these claims except for the a protective grid. The Examiner then states that Kawaguchi et al. disclose these missing limitation and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Young pot with Kawaguchi et al. protective grid. Applicants respectfully disagree.

Each of the rejected claims requires a number of limitations not disclosed or suggested by the combination, such as rodent deterrent applied so as to not block passageways defined by elongate fibers. Consequently, the present combination cannot render claims 2 and 3 obvious.

For at least this reason, Applicants respectfully request that the Examiner withdraw the present rejection.

Young

The Examiner has rejected claim 4 under 35 U.S.C. § 103 as being obvious in view of the Young patent, discussed above, and ordinary skill in the art, stating that Young discloses all of the limitations of this claim. The Examiner then states that seashells are well-known as a rodent deterrent and as decorative elements and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to substitute seashell fragments for Young's cinders. Applicants respectfully disagree.

Claim 4 includes, through its dependency from amended claim 1, limitations such as a container made of elongate fibers. As discussed above relative to the anticipation rejection in view of the Young patent, Young does not so much as suggest such as container. Consequently, Young does not render claim 4 obvious. For at least this reason, Applicants respectfully request that the Examiner withdraw the present rejection.

Fernando et al., Young and Okii et al.

The Examiner has rejected claims 9, 10 18 and 27 under 35 U.S.C. § 103 as being obvious in view of the Young and Fernando et al. references, discussed above, and further in view of U.S. Patent No. 4,945,059 to Okii et al., stating that Young and Fernando et al. disclose

all of the limitations of these claims except for a growth enhancer. The Examiner then states that Okii et al. disclose a growth enhancer and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Young/Fernando et al. device with the growth enhancer disclosed by Okii et al. in the manner claimed in these claims. Applicants respectfully disagree.

The Young and Fernando et al. patents are as described above.

Okii et al. disclose a method of proliferating fungi and adding the fungi to soil to enhance the utilization of fertilizer by plants planted in the soil.

As discussed above, claims 9, 10, 18 and 27, by virtue of their respective dependencies from amended claims 1, 12 and 24, contain limitations not disclosed or suggested by any of the references of this combination. Therefore, these claims are not obvious in view of the combination.

In rebutting Applicants' prior arguments on this combination, the Examiner states on page 13 of the present Office Action that "Okii teaches the fungi in the soil, the soil in the pot, thus, the fungi is attached to the pot." This is not true because it ignores the plain and ordinary meaning of the word "attached." As defined in numerous dictionaries (see, e.g., www.onelook.com), such as the Encarta online dictionary and the Merriam Webster dictionary (both available through www.onelook.com), the word attached means "to make fast (as by tying or gluing)" (Merriam Webster) or "secure something to something else: secure one thing to another" (Encarta). It is simply not reasonable to assert that by adding fungi to a hole in soil that is contained within a pot results in the fungi being attached to the pot.

By analogy, the plant that is in the Okii et al. pot is also in the soil, which is in the pot. Applicants assert that it is not reasonable to say that the plant is secured, made fast or attached to the pot. Soil in a pot, particularly the soil in the Okii et al. patent, is not a securing medium, such as a bonding agent or fastener. It is likewise not reasonable to say that the fungi is secured, made fast or attached to the pot.

On page 13 of the present Office Action, the Examiner also asserts that the fungi is in a solution so that when the solution is applied to the soil it will soak to the wall of the plant such that the fungi attaches to the pot. This is merely conjecture. There is no evidence whatsoever

that the fungi (the solute) will reach the pot, even if the solvent part of the solution does. Perhaps the soil acts as a filter to filter the fungi out of the solution before the solvent reaches the pot. Applicants assert that without proof that the fungi indeed reaches the interior surface of the pot and becomes secured thereto, the Examiner has not made a *prima facie* obviousness rejection. If the Examiner persists in making this rejection, Applicants respectfully assert that the Examiner must back such assertion with actual evidence that it is true.

Furthermore, in the Examiner's blanket statement regarding the Okii et al. patent on page 13 of the present Office Action, the Examiner has not addressed the limitation of claim 27 that includes the step of releasing a growth enhancer from the container. Even if one were to view the Examiner's position on the attachment issue as proper, which it is not, Okii et al. is completely silent on releasing a growth enhancer from a container.

Moreover, claim 9, as amended, includes the limitation that the growth enhancer is applied to at least a portion of the interior face of the container. The word "apply" connotes that the growth enhancer is intentionally applied to the interior face of the container. Again, see www.onelook.com. In the Okii patent, any contact of the fungi with the interior face of the pot (which, again, is not supported by Okii) is unintentional and, therefore, does not fit the plain and ordinary meaning of "apply."

For at least the foregoing reason, Applicants respectfully request that the Examiner withdraw the present rejection.

Fernando et al. and Kawaguchi et al.

The Examiner has rejected claims 13, 25, and 26 under 35 U.S.C. § 103 as being obvious in view of the Fernando et al., Young and Kawaguchi et al. references, discussed above, stating that Fernando et al. disclose all of the limitations of these claims except the grid cover. The Examiner then states that Kawaguchi et al. disclose a grid cover and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Fernando et al. pot with the grid cover of Kawaguchi et al. Applicants respectfully disagree.

Claims 13, 25, and 26 depend from claim 12 or 24, which, as discussed in the previous section, have been amended to include a limitations not disclosed or suggested by Fernando et al.

and/or Young. Kawaguchi et al. also do not disclose these limitations. Therefore, the combination cannot render claims 13, 25, and 26 obvious.

For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the present rejection.

Fernando et al. and Okii et al.

The Examiner has rejected claims 20 and 22 under 35 U.S.C. § 103 as being obvious in view of the Fernando et al. reference and the Okii et al. patent (each described above), stating that Fernando et al. disclose all of the limitations of these claims except for a growth enhancer. The Examiner then states that Okii et al. disclose the missing limitation and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Fernando et al. pot with the growth enhancers disclosed by Kawaguchi et al.

Applicants respectfully disagree.

As discussed above relative to the obviousness-type rejection made in view of Fernando et al., Young and Okii et al., Okii et al. does not disclose or suggest a growth enhancer attached to the wall of the pot. Fernando et al. is also completely silent on this limitation. Therefore, the Fernando et al./Okii et al. combination cannot render obvious claims 20 and 22.

For at least the foregoing reason, Applicants respectfully request that the Examiner withdraw the present rejection.

Fernando et al., Okii et al. and Iwasaki et al.

The Examiner has rejected claim 21 under 35 U.S.C. § 103 as being obvious in view of the Fernando et al. and Okii et al. references, described above, and further in view of U.S. Patent No. 4,844,734 to Iwasaki et al., stating that Fernando et al. and Okii et al. disclose all of the limitations of this claim except for the growth enhancer being ground-up seashells. The Examiner then states that Iwasaki et al. disclose the missing limitation and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Fernando et al./Okii et al. device with the ground-up seashell disclosed by Iwasaki et al. Applicants respectfully disagree.

Claim 21 requires that the seashells be attached to the wall of the container as a nutritive growth enhancer. As discussed above relative to the Fernando et al., Young and Okii et al.

rejection, Okii does not reasonably disclose a growth-enhancer attached to the wall of the pot. Neither Fernando et al. nor Iwasaki et al. disclose this feature, either. Therefore, the combination cannot render claim 21 obvious.

For at least this reason, Applicants respectfully request that the Examiner withdraw the present rejection.

Fernando et al., Okii et al. and Kawaguchi et al.

The Examiner has rejected claim 23 under 35 U.S.C. § 103 as being obvious in view of the Fernando et al., Okii et al. and Kawaguchi et al. references, described above, stating that Fernando et al. and Okii et al. disclose all of the limitations of this claim except for the grid cover. The Examiner then states that Kawaguchi et al. disclose the missing limitation and asserts that it would have been obvious to a person having ordinary skill in the art at the time of the invention to provide the Fernando et al./Okii et al. device with the grid cover disclosed by Kawaguchi et al. Applicants respectfully disagree.

Claim 23 requires that the seashells be attached to the wall of the container as a nutritive growth enhancer. As discussed above relative to the Fernando et al., Young and Okii et al. rejection, Okii does not reasonably disclose a growth-enhancer attached to the wall of the pot. Neither Fernando et al. nor Iwasaki et al. disclose this feature, either. Therefore, the combination cannot render claim 23 obvious.

For at least this reason, Applicants respectfully request that the Examiner withdraw the present rejection.

Conclusion

In view of the foregoing, Applicants respectfully submit that claims 1-10, 12, 13, 15-18, 20-27, and 33-36, as amended, are in condition for allowance. Therefore, prompt issuance of a Notice of Allowance is respectfully solicited. If any issues remain, the Examiner is encouraged to call the undersigned attorney at the number listed below.

Respectfully submitted,

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Attachment

Webpage printout "Plaster Track Casting Procedure"

BTv.471016.1